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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/286,530 04/05/99 CHAPOY L 7651/1239

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO IL 60610

QM12/0117

EXAMINER

PREBILIC, P

ART UNIT

PAPER NUMBER

3738

DATE MAILED:

#7
01/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/286,530

Applicant(s)
Chapoy et al

Examiner
Paul Prebille

Group Art Unit
3738



☒ Responsive to communication(s) filed on Oct 23, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-53 is/are pending in the application.

Of the above, claim(s) 24-39 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, 4-17, 19-23, and 40-53 is/are rejected.

☒ Claim(s) 3 and 18 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Election/Restriction

Applicant's election with traverse of Group I and species 1 in Paper No. 6 filed October 23, 2000 is acknowledged. The traversal is on the ground(s) that there is no additional burden to search Group II since claim 2 has the same limitation as set forth in independent claim 28 of Group II. This is not found persuasive because product and method claims are interpreted quite differently even with the same method limitations therein. In particular, since claim 2 only requires the Examiner to find the product suggested by the method, the burden of finding the method step thereof is not present therein; see MPEP 2113 which is incorporated herein by reference thereto.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

The corrected or substitute drawings were received on May 9, 2000. These drawings were approved by the Draftsman and by the Examiner.

Claim Objections

Claims 40-53 are objected to because of the following informalities: On lines 1-2 of claim 40, the language "comprises an intraocular lens" is a statement of intended use. The Examiner suggests using the language "shaped in the form of an intraocular lens" instead. Appropriate correction is respectfully requested.

In claim 42, line 1, the language "haptic is a filament" should be ---haptic is shaped into a the form of a filament--- in order to clearly claim structure.

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In claim 43, it is unclear what "comprises two plate haptics". Instead, the Examiner suggests using "wherein the at least one haptic is in the form of two plates"

Claim Rejections - 35 USC § 112

Claims 4-7 and 19-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims apparently attempt to broaden the claim scope of the claim they depend upon because the claims they depend upon require that all 5 listed polymers be present. For this reason, claims 4-7 and 19-22 will be interpreted as having the same scope as the claims they depend upon either claim 3 or claim 18.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Heller et al (US 5,108,819) wherein the polyimide film promotes fibrosis to the extent required because it is the same material as claimed; i.e. polyimide; see the entire document.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 14-17, 23, and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cumming (US 5,047,051) in view of Cahalan et al (US 5,415,938). Cumming discloses a plate and filament haptic but not the polyimide coating as claimed. Cahalan et al, however, teaches that it was known to coat intraocular lenses with a polyimide or an imide containing polymer (i.e. carbodiimide) in order to improve the biocompatibility of the device. Hence, it is the Examiner's position that it would have been obvious to coat the Cumming device over the entire surface with the coating of Cahalan et al for the same reasons that Cahalan et al does the same.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cumming and Cahalan et al as applied to claims 1, 2, 14-17, 23, and 40-43 above, and further in view of Patel et al (US 6,158,862). Cumming fails to disclose the use of a UV absorbing compound in the lens as claimed. Patel et al, however, teaches that it was known to add UV absorbing compounds to similar implants in order to protect the retina in much the same way the natural lens does the same. Hence, it is the Examiner's position that it would have been obvious to incorporate a UV absorbing compound into the intraocular lens of Cumming for the same reasons that Patel et al does the same.

Claims 9, 12, 13, 44-46, and 49-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cumming and Cahalan et al as applied to claims 1, 2, 14-17, 23, and 40-43

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above, and further in view of Doyle et al (US 5,527,415). Cumming fails to disclose primered coatings as set forth in the present claims and suggested by the method of making limitations. Applicant is directed to note that method of making limitations have a lesser burden of proof for the Examiner because of their peculiar nature; see MPEP 2113 which is incorporated herein by reference. Hence, it is the Examiner's position that it would have been obvious to apply a primer as taught by Doyle et al in order to improve coating adhesion of the polyimide coating.

Claims 9-11, and 46-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cumming and Cahalan et al as applied to claim 1, 2, 14-17, 23, and 40-43 above, and further in view of Adams et al (US 5,326,505). Cumming fails to disclose the presence of a corona discharge treated surface as required by the method of making limitation of the present claims. However, Adams et al teaches that it was known to corona discharge treat similar surfaces in order to promote adhesion of the coating as claimed. Hence, it is the Examiner's position that it would have been obvious to corona discharge treat the Cumming surface for the same reasons that Adams et al does the same.

Claims 3 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 4-7 and 19-22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 305-3580.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic
Primary Examiner
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